

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of : McCormack, Tony
Serial No. : 09/878,874
Filed : June 11, 2001
For : Establishing Telephone Calls at Specified Times
Examiner : Haresh N Patel
Art Unit : 2454
Customer Number : 23644
Confirmation No. : 2638

RESPONSE TO FINAL OFFICE ACTION DATED AUGUST 18, 2009

Honorable Director of Patents and Trademarks
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir,

This response is being filed in view of the Examiner's further and final Office Action of August 18, 2009 regarding this application. While the indicated allowability of the subject matter of claims 8 and 28 is gratefully acknowledged, it is submitted that all claims are allowable, and reconsideration by the Examiner is therefore requested.

In the Office Action, the Examiner had three rejections of claims 1 and 11 under 35 U.S.C. § 102(e), as either being anticipated by Drozdzewicz, Johnsson or Doganata. The Examiner then has further rejections of the claims under 35 U.S.C. § 103(a).

Turning first to claims 27-30 that are not handled in the Office Action, given the prior prosecution of the application, it is clear that those claims should have been indicated to be allowable. The Examiner's clarification would be appreciated.

Turning to the various rejections, the lengthy "Response to Arguments" set out on page 4 of the office action is largely a repetition of remarks put forward by the applicant.

In what follows the Examiner does not respond specifically to the points put forward by the applicant but merely makes general statements to justify the positions taken.

Claims 1 and 11 stand rejected as anticipated by Drozdzewicz as per the office action of 1/13/2009. In the action of 1/13/2009 only page 1 of Drozdzewicz is referred to. The examiner now refers to "the cited portions among other places of the cited art ..."

However, as noted in applicant's previous response, applicant has studied the cited art in detail and has not found the limitations of claims 1 and 11, particularly item (ii) comparing a current time with associated time ranges to select an appropriate one of a plurality of call destinations ...

Similarly with respect to all of the references that have been cited against the various claims the applicant has carefully studied the portions of the text that the examiner has cited, as well as the remainder of the text of those documents, and as explained in the previous response has not been able to find all of the limitations of the claims presently on file.

The applicant stated clearly in response to the previous action that it is not able to find the limitations in the cited art. Having done so the applicant is entitled to an explanation as to where those limitations are to be found. It is not sufficient simply to say the respective prior art discloses the "broadly claimed limitations" when these limitations are defined in precise terms in the claims.

Nor is it submitted to be acceptable to rely on the general statement on page 14 as a basis for inferring that the scope of the claims is not defined by the words chosen for them but is somehow broader. The scope of a patent is defined by the claims. The general statement on page 14 is intended to emphasize that the described embodiment is not limiting on the scope of the patent and that modifications are possible within the scope of the claims. It is true that a range of applications is possible within the scope of the invention but only insofar as they fall within the wording of the claims.

The examiner goes on to state "when reviewing a reference, the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated when formulating an objection".

The foregoing is not correct for a rejection based on anticipation.

When assessing novelty only the specific teachings of a reference should be relied on. Inferences cannot be relied on for a proper anticipation rejection.

The foregoing two points demonstrate what applicant submits is a failure to correctly apply the law by the Examiner, making it impossible for the applicant to either properly respond or even understand the bases for the rejections.

Furthermore, if an examiner is relying on inferences from a reference to formulate some other kind of rejection, the applicant is entitled to know what they are and how they are derived. The applicant has been deprived of such information in the present case.

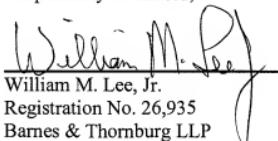
The use of multiple references to demonstrate that several references disclose the subject matter of the claims is not helpful when no combination of those references in fact discloses all of the limitations of the claims. This piecemeal approach by the examiner is not helpful in expediting the prosecution of the application.

Reconsideration of the detailed remarks previously put forward by the applicant is respectfully requested. Only then can the applicant understand what the Examiner's rejections may be and appropriately respond. Given the above, it is submitted that the Examiner should withdraw the finality of the Office Action and issue a proper Office Action, if the rejections are to be maintained.

Further action by the Examiner is therefore awaited. As this response is being submitted during the fourth month following the Examiner's Office Action, an appropriate Petition for Extension of Time is also submitted herewith.

December 18, 2009

Respectfully submitted,



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